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In re Application of :
Robert John Mabbott :
Application No.: 08/716,360 :
PCT No.: PCT/GB95/00601 : DECISION ON PETITIONS
Int. Filing Date: 17 March 1995 :
Priority Date: 18 March 1994 :
Attorney Docket No.: 16286-702 :
For: TRANSFER MATERIALS :
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This is a decision on applicant's petition under 37 C.F.R. § 1.47(b) filed in the Patent and Trademark Office (PTO) on 21 March 1997 and on the request for a refund filed 15 November 1996.

BACKGROUND

On 17 March 1995, applicant filed international application No. PCT/GB95/00601 which claimed a priority date of 18 March 1994, and which designated the United States. A Demand electing the United States was filed 04 October 1995.

On 17 September 1996, a transmittal letter for entry into the national stage in the United States was filed which was accompanied by, inter alia, the basic national fee.

On 23 October 1996, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge for furnishing the oath/declaration after 30 months from the priority date were required.

On 15 November 1996, a statement claiming small entity status was filed together with a request for a refund.

On 21 March 1997, the present petition was filed and was accompanied by, inter alia: an general authorization to charge any fees required including the requisite \$130.00 petition fee to counsel's deposit account; a petition and authorization to charge the \$735.00 fee for a four month extension of time to counsel's deposit account, a declaration by the 37 CFR 1.47(b) applicant on behalf of the alleged non-signing inventor, Robert John Mabbott, and general authorization sufficient to charge the \$65.00 surcharge for furnishing the declaration after 30 months from the priority date to counsel's deposit account, and separate declarations in support of the petition. The above-noted fees have been charged to counsel's deposit account No. 23-2415.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Petitioner has satisfied items (1), (3), (5) and (6) above.

Regarding item (2) above, petitioner has not provided sufficient proof that the inventor refuses to execute the application or cannot be reached after diligent effort. Where inability to find or reach a non-signing applicant, after diligent effort, is being alleged an affidavit or declaration of facts should be submitted which fully describe the exact facts which are being relied upon to establish that a diligent effort was made. The affidavit or declaration of facts must be signed, where at all possible, by a person having first hand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of any documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., which support a finding that the non-signing inventor could not be found or reached should be made a part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Petitioner has provided a declaration of Alan Bryan Porter indicating that "Since August 1995 when efforts were made to obtain Mr. Mabbott's signature on the application Serial No. 08/454334 we have been unable to establish the whereabouts of Mr. Mabbott." However copies of any letters and facsimile communications were not provided. Statements from person(s) having firsthand knowledge of the efforts made to locate Mr. Mabbott, including the private investigator employed, should be furnished detailing the efforts made. Copies of any documentary evidence should be provided. Was a copy of the application comprising the specification, including the claims, drawings and declaration/oath therefore mailed or otherwise attempted to be presented to the nonsigning inventor. Is correspondence mailed to Mr. Mabbott at his last known address returned as undeliverable? If so, such should be documented. The details surrounding the efforts made to contact Mr. Mabbott

including a copy of any correspondence mailed and the dates and times of any attempted telephone contacts should be provided via statements of person(s) having firsthand knowledge thereof. Examples of evidence to be submitted, if available include copies of any documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., which support a finding that the non-signing inventor could not be found or reached. Furthermore, statement(s) regarding any telephone conversations from the person(s) having firsthand knowledge should be provided including the date and time thereof to the extent such conversations, if any, relate to either the inability to locate Mr. Mabbott, or the refusal of Mr. Mabbott to sign the oath/declaration for this application. The specific efforts made, including the method(s) used, in attempting to present the application to Mr. Mabbott for execution should be presented in detail in any statements presented. Copies of any documentary evidence associated with such attempts are required. The copy of the statements regarding the efforts to secure the signature of Mr. Mabbott for another application are not sufficient for proving the unavailability of Mr. Mabbott to sign the present application.

In view of the above, item (2) has clearly not been satisfied.

Regarding item (4) above, the combined declaration and power of attorney does not indicate the title of the person signing on behalf of the legal entity.

Accordingly, it is inappropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

REFUND REQUEST

Since the small entity statement received 15 November 1996 was filed within two months of the date of the timely payment of the full fee, a refund of 1/2 of the basic national fee and excess claim fees paid is in order pursuant to 37 CFR 1.28(a) and 37 CFR 1.26. The \$506.00 (\$440.00 for the excess fees paid for the basic national fee and \$66.00 for the excess fees paid for extra claims) refund due will be credited to counsel's deposit account No. 23-2415.

CONCLUSION

The petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

The request for a refund is GRANTED as indicated above.

If reconsideration on the merits of the petition under 37 CFR 1.47(b) is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.



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